

11 MAY 2009



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In re Application of	:	
HOFMANN et al.	:	DECISION
Application No.: 10/564,669	:	
PCT No.: PCT/EP2004/052875	:	
Int. Filing Date: 08 November 2004	:	
Priority Date: 20 December 2003	:	
Attorney's Docket No.: 3474	:	
For: INSERTION TOOL FOR A MACHINE TOOL	:	

This is a decision on the submission filed by applicants on 11 February 2009, which includes petitions under 37 CFR 1.137(b), 1.42, and 1.47(a).

**BACKGROUND**

On 08 November 2004, applicants filed international application PCT/EP2004/052875 which designated the U.S. and claimed a priority date of 20 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expires at midnight on 20 June 2006.

On 13 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and three declarations of inventors. The indication in the declaration that inventor Markus HECKMANN is deceased has been treated as a request for status under 37 CFR 1.42.

On 24 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AN 37 CFR 1.495 (Form PCT/DO/EO/903) according the application a 35 U.S.C. § 371(c)(1), (c)(2), and (c)(4) date of 13 January 2006 and a 35 U.S.C. 371 date of 13 January 2006.

On 04 April 2008, a decision was mailed refusing applicants' request for status under 37 CFR 1.42 because the declarations did not include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)) in addition to the *full name and citizenship of the deceased inventor* (37 CFR 1.497(a)(3)). The decision also

noted

(1) that the declarations of inventors filed 13 January 2006 were not in compliance with 37 CFR 1.497(a)-(b) because they did not list the inventorship set forth in the international application (The declarations identify two additional inventors (Christof Hoelzl and Johan Huber) compared to the international application.),

(2) the declarations filed 13 January 2006 were not sufficient because each contained non-initialed alterations (page 2 of each declaration),

(3) the declaration of inventors signed by Albrecht Hofmann, Harald Krondorfer, Thomas Schomisch, and Christof Hoelzl was not in compliance with 37 CFR 1.497(a)-(b) because it did not list Markus Heckmann's citizenship in addition to the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)). (The third page of this declaration is missing.), and

(4) the three declarations of inventors filed 13 January 2006 were not in compliance with 37 CFR 1.497(a)-(b) because none of them were executed by the legal representative.

The decision also vacated the NOTIFICATION OF ACCEPTANCE mailed 24 April 2006.

Finally, the decision set a two-month extendable time period for response.

On 30 July 2008, a Notice of Abandonment was mailed indicating that the application was abandoned for failure to timely file a proper reply to the Office letter mailed on 04 April 2008.

On 17 November 2008, applicants filed a petition, which was properly treated as a petition under 37 CFR 1.181, requesting that the application be reinstated.

On 02 February 2009, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.181 that the application be reinstated.

On 11 February 2009, applicants filed the instant submission which includes petitions under 37 CFR 1.137(b), 1.42, and 1.47(a).

## **DISCUSSION**

### **Petition under 37 CFR 1.137(b)**

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted a proper reply (see sections "Petition under 37 CFR 1.47(a)" and "Petition under 37 CFR 1.42" below) on 12 February 2009.

As to item (2), applicant submitted the petition fee on 12 February 2009.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

#### Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee has been charged to Deposit Account 19-4675. Thus, item (1) has been met. Items (3) and (4) have also been met. Item (2) has been met as well. It has been established that Kersten Heckmann, the legal representative of deceased inventor Markus Hecmann, was presented with a copy of the application papers including the specification. Kersten Heckmann's conduct constitutes a refusal to sign.

#### Petition under 37 CFR 1.42

The indication in the declaration that Markus HECKMANN is deceased has been treated as a request for status under 37 CFR 1.42.

The submission filed 11 February 2009 has been reviewed and has been found in compliance with 37 CFR 1.42. The declaration filed 11 February 2009 is in compliance with 37 CFR 1.497(a)-(b).

### CONCLUSION

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.137(b) is **GRANTED**.

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.42 is **GRANTED**.

For the reasons set forth above, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **11 February 2009**.

/Daniel Stemmer/

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HOFMANN et al.  
Application No.: 10/564,669  
PCT No.: PCT/EP2004/052875  
Int. Filing Date: 08 November 2004  
Priority Date: 20 December 2003:  
Attorney's Docket No.: 3474  
For: INSERTION TOOL FOR A MACHINE TOOL

Dear Mrs. Heckmann:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

/Daniel Stemmer/

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